generating a code on the user-selected computer in response to a request to purchase a particular software program, wherein the code identifies at least one software program in the plurality of software programs and contains information relating to sampling of the software program by the user; and

providing the code to the distribution center upon selection of the particular software program for purchase by the user, the distribution center using the code to generate a password for unlocking the particular software program on the user-selected computer.

REMARKS

I. Provisional Double Patenting Rejection

In the Office Action dated November 20, 1997, the Examiner provisionally rejected claims 1-12 and 14-25 under the judicially created doctrine of obviousness-type double-patenting as being unpatentable over claims 1-17 of copending application Serial No. 08/485,637. The Assignee of the present application previously filed a Terminal Disclaimer to Obviate a Provisional Double-Patenting Rejection in copending application Serial No. 08/485,637 over the present application. Because the rejection in the present application is provisional, Applicant is deferring, without prejudice, filing a Terminal Disclaimer in the present application until it appears that the provisional rejection in the present application will be converted into an actual double-patenting rejection because the copending '637 application will issue prior to the present application issuing. If a Notice of Allowance is issued in the copending '637 application prior to a Notice of Allowance being issued in the present application, Applicant will, if necessary, file a petition to request that the previously filed Terminal Disclaimer in the copending '637 application be withdrawn prior to issuance.

II. Rejections Under 35 U.S.C. §§ 102 and 103

This amendment is submitted in response to the Office Action dated November 20, 1997. Independent claims 13, 26 and 27 were rejected under 35 U.S.C. §102 as being anticipated by U.S. Patent No. 5,625,690 issued to Michel et al. and by U.S. Patent No. 5,014,234 issued to Edwards, Jr. Claims 1-12 and 14-25 were indicated as being allowable over

the prior art of record subject to the filing of a terminal disclaimer. Claims 13 and 26 have been amended, claim 27 has been canceled without prejudice, and new claim 28 has been added. No new matter has been added. Reexamination and reconsideration are respectfully requested.

Applicant respectfully traverses the Examiner's 35 U.S.C. §102 rejections of claims 13, 26 and 27. Applicant submits that amended independent claims 13 and 26 and new claim 28 are patentably distinct over the Michel '690 and Edwards '234 references. Neither the Michel '690 reference nor the Edwards '234 reference teach the use of a code as claimed in amended claims 13 and 26 and new claim 28.

The amended claim 13 recites generating a code on the user-selected computer for use in unlocking the software programs, wherein the code includes an identification of which ones of the plurality of software programs were sampled and how many times each of the plurality of software programs was sampled by the user. Amended claim 26 and new claim 28 recite generating a code that includes an identification of at least one software program in the plurality of software programs and that contains information relating to the sampling of the software program. Amended claims 13 and 26 also recite a purchase means that requires "the code to be provided to the distribution center" wherein the distribution center uses the code "to generate a password for unlocking the particular software program" selected by the user to be purchased. New claim 28 recites the step of "providing the code to the distribution center" wherein the distribution center uses the code "to generate a password for unlocking the particular software program" selected for purchase by the user. Thus, the claims clearly recite how a code is generated to be used for unlocking particular software selected for purchase by a user and how the same code carries marketing data, such as which programs were sampled, how many times the programs were sampled and information related to the sampling of the programs. The code and its associated marketing data are provided to a distribution center as a part of the purchase transaction for the particular software program selected for purchase and the distribution center uses the code to generate a password for unlocking the particular software program. Support is found for the amendments to claims 13 and 26 and for new claim 28 throughout the specification and particularly on pages 21-23 and 26-28 and in Figures 19 and 21.

The Michel '690 patent does not teach or suggest a system, computer program

5

product or method as recited in amended claims 13 and 26 and new claim 28. First, the Michel '690 reference does not teach or suggest generating a code "on the user-selected computer" that includes an identification of which ones of the plurality of software programs were sampled and how many times each of the plurality of software programs was sampled as in claim 13, or that includes identification of at least one software program of a plurality of software programs and information relating to the sampling of the software program as in claims 26 and 28. Rather, Michel '690 teaches the use of a software ID number generated by a remote validation system, and random public and private keys and a DES key also generated by the software validation system. The user system in Michel generates random numbers which are then used in an encryption/decryption/masking scheme to retrieve the DES key from the software validation system. There is no teaching or suggestion to use the random numbers generated by the user system to contain data related to the sampling of software programs as recited in claims 13, 26 and 28 of the present application. In fact, there would be no reason to look to Michel for gathering data related to the sampling of software programs as recited in claims 13, 26 and 28 of the present application, because Michel teaches a pay-per-use system in which all of the uses are pre-paid and, therefore, there are no "demonstrations" from which such data needs to be gathered. Finally, the software validation system does not use the random numbers from the user system to "generate a password for unlocking the particular software program" as in the presently amended claims 13 and 26 and new claim 28. Rather, in Michel, the random numbers are used to mask the DES key, which was previously generated during the initial software validation routines by the software validation system.

The Edwards '234 patent also does not teach or suggest a system, computer program product or method as recited in amended and new claims 13, 26 and 28, respectively. The Edwards '234 patent teaches the use of registration data that includes a serial number provided to a user at installation and saved in a file for future reference should the user decide to register the software and begin paying a fee for its use. Thus, even if the user provides the serial number to the proprietor of the software in order to purchase the software, the serial number does not contain data related to the sampling of software programs as recited in claims 13, 26 and 28, as it remains constant. The registration data includes the serial number and also includes a

6

counter that is incremented or decremented every time the registration data is tested, which occurs each time the software or any module thereof is operated. Thus, the registration data does not include data related to the sampling of software programs such as "which ones of the plurality of software programs were sampled" or "how many times each of the plurality of software programs was sampled by the user" because the counter does not even differentiate between modules. Moreover, the value of the counter is also not useful marketing data because, depending upon the number of times the software and its modules have been executed, the counter may have been incremented and decremented. Finally, there is no teaching or suggestion to include data related to the sampling of software programs in the registration data and to then provide the registration data to a distribution center, because only the serial number is needed to defuse the software and the serial number remains constant after installation of the registration data. This is contrary to amended claims 13 and 26 and new claim 28, in which the code, including data related to the sampling of software programs, is used by a distribution center to generate a password for unlocking the software selected to be purchased. Thus, unlike the Edwards '234 reference, in the presently amended and new claims, the data related to the sampling of software programs is necessary to the proper functioning of the purchase transaction and is, therefore, automatically provided to a distribution center when the user takes the appropriate steps to purchase a software program.

Applicant has eliminated the recitation of "undivided" in the means for maintaining the software programs in an "undivided" locked state, as it is believed that the amendments herein patentably distinguish over U.S. Patent No. 5,341,429 issued to Stringer et al. and U.S. Patent No. 5,563,946 issued to Cooper et al. The Stringer '429 patent teaches the use of generating a transaction code or product identification number, which is then provided to a vendor at a remote location. The vendor then verifies that the transaction code is valid and issues an enabling code that is provided to the user to enable the software. There is no teaching or suggestion to include data related to the sampling of software programs in the transaction code. In fact, Stringer teaches using a checksum technique to generate the product identification code in which the product identification number adds up to a predetermined number. In addition, there is no teaching or suggestion in Stringer for the remote vendor to use the transaction code to

generate the enable code, as in amended claims 13 and 26 and new claim 28.

In the Cooper '946 reference, a user receives a temporary access key from a vendor for temporarily accessing software provided by the vendor. If the user decides to purchase the software through the vendor, the vendor provides the user with a permanent access key. There is no teaching or suggestion for the user's system to generate a code that includes data related to the sampling of software programs, and to then provide the code to the vendor for use in generating the permanent access key or password, as in amended claims 13 and 26 and new claim 28.

Other references previously relied upon by the Examiner also do not teach the use of a code, generated by the user-selected computer, for use in unlocking a particular software program selected for purchase by a user, wherein the code includes data related to the sampling of software programs as recited in claims 13, 26 and 28. In addition, none of the cited references teach requiring the code, which includes the data related to the sampling of software programs, to be provided to a distribution center during a purchase transaction of a particular software program selected by the user, wherein the distribution center uses the code to generate a password for unlocking the particular software program. The use of the code as recited in amended claims 13 and 26 and new claim 28 to generate a password for enabling the use of the particular software program selected for purchase ensures that, whenever software is purchased by a user, the data related to the sampling of software programs is received by the distribution center for any desired marketing analysis. Applicant respectfully submits that these features are not found in any of the references relied upon by the Examiner and would not have been an obvious solution to the problem of obtaining such data from software demonstrations.

CONCLUSION

Applicant respectfully submits that claims 13 and 26 as amended herein and new claim 28 are patentably distinguishable over the references cited by the Examiner in this and previous Office Actions, and, therefore, claims 13, 26 and 28 are in condition for allowance. Therefore, Applicant respectfully requests a Notice of Allowance for all claims 1-26 and 28, which are remaining in the application.

If a telephone conference would be helpful in resolving any issue, the Examiner is urged to contact the undersigned attorney at (612) 336-4607.

Respectfully submitted,

MERCHANT, GOULD, SMITH, EDELL,
   WELTER & SCHMIDT, P.A.
3100 Norwest Center
90 South 7th Street
Minneapolis, Minnesota 55402
(612) 332-5300

Dated: _March 20, 1998_   By: _Leslie E. Dalglish_
                                    Leslie E. Dalglish
                                    Reg. No. 40,579